



Docket: T2211-908553

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:	:
BLUNDSTONE PTY LTD.	: Trademark Attorney:
	: Chrisie Brightmire King
	:
Serial No.: 76/519,909	: Law Office: 103
	:
Filed: June 4, 2003	:
	:
For: MATADOR	:
	McLean, Virginia
	August 15, 2005

**COMBINED REQUEST FOR EXTENSION OF TIME
TO FILE APPEAL BRIEF AND REQUEST FOR REMAND
TO CONSIDER CONSENT TO USER AGREEMENT**

BOX: TTAB

To the Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

This paper is filed in response to the Office Action dated August 12, 2004, and as
a Supplement to Applicant's Notice of Appeal.

REMARKS

Favorable reconsideration of the present application is respectfully requested in
view of the Consent to Use Agreement reached between Applicant and Pyramex Safety
Products, LLC.

A copy of the Consent to Use and Register marked as Exhibit A is attached
hereto, and Applicant requests that it be made of record.



The outstanding Office Action of August 12, 2004, from which an Appeal has been taken contains a refusal to register the mark under Section 2(d) in view of existing Registration No. 2,745,319, to Pyramex Safety Products, LLC (“the Pyramex registration”). This refusal to register is respectfully traversed, in that the mark of the present application and the marks of the cited registration, when used on the respective goods, will not give rise to a likelihood of confusion, particularly in view of the Consent to Use and Register Agreement signed by Pyramex Safety Products, LLC.

The cited registration is directed to, “safety spectacles and industrial eyewear; namely protective glasses and goggles”. Applicant’s goods relate to entirely different products. The Office Action states that the Examiner disagrees with the arguments previously presented, namely that the goods travel in different channels of trade and that consumers would not expect Applicant’s goods to emanate from the same source as Registrant’s industrial eyewear.

The Office Action further asserts that the goods of the registration are within the Registrant’s normal field of expansion.

Based on the foregoing, the Examiner reached the conclusion that a likelihood of confusion as to the source of Applicant’s products would exist and refused Applicant’s application for registration for the goods set forth in the application.

Applicants reaffirms its argument to the effect that the products set forth in the application are believed to also travel in different channels of trade than do the product set forth in the Pyramex registration. The protective glasses and goggles are likely to be sold through industrial supply companies to companies operating factories or other industrial operations, or to individuals who work in such an environment. In contrast, the

protective clothing and footwear of the present application will generally be sold through more traditional retail outlets, such as department stores, hardware stores, clothing shops and shoe stores. Such consumers will not likely be confused into believing that the respective product all come from the same source.

Persons purchasing protective eyewear will exercise greater care than would consumers purchasing more ordinary goods. There is no reason to assume that the Matador protective clothing and footwear would come from the same source or has some affiliation with Matador protective glasses and goggles. Rather, the more cautious or careful consumer is likely to believe that the types of products (eyewear vs. clothing and footwear) are sufficiently different that they would not make such an assumption.

The refusal to register the mark MATADOR for protective clothing and safety footwear, under Section 2(d), in view of the Pyramex registration, is therefore not supportable and should be withdrawn.

The question was put to the one most likely to be damaged by any confusion, the owner of Registration 2,745,319, Pyramex Safety Products, LLC. Pyramex had no problem joining in the attached Consent to Use and Register Agreement. As noted therein, Pyramex believes there would be no likelihood of confusion as to the source of the goods marketed, offered, or intended to be marketed or offered by Applicant under the mark MATADOR.

Pyramex and Applicant have further agreed that their respective use of the mark MATADOR will be limited to the goods of their respective registration and application and that they will cooperate to avoid confusion and take steps to correct any confusion in the unlikely event that something should occur.

The Courts and the Trademark Trial and Appeal Board have consistently held that an Agreement between a prior registrant and an applicant should be given substantial weight in consideration of the question of likelihood of confusion. Amalgamated Bank of N.Y. v. Amalgamated Trust & Savings Bank CFRC 87-1516, PTCJ Vol. 35, No. 874, p. 457 (1988); In re Fieldcrest Cannon Inc. 5 USPQ2d 1142; Bongrain International (American) Corp. v. Delice de France, Inc. 1USPQ2d 1775 (1987); and E.I. Du Pont De No Morris & Co. 177USPQ563 (1973).

The effect of consent to use agreements and the manner in which they should be treated is perhaps best illustrated in the words of Chief Judge Markey in the CCPA RALLY decision:

“The weight to be given more detailed agreements...should be substantial. It can be safely taken that reputable businessmen-users of valuable trademarks have no interest in causing public confusion...Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter into agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. As we read them, the very purpose and aim of the present agreements is the avoidance of public confusion.”

E.I. Du Pont, supra.

The Examiner's attention is invited to the case of In re Leonard S.A. where the Board, although agreeing with the Examiner's conclusion as to likelihood of confusion absent a Consent to Use Agreement, nevertheless reversed the Examiner based on a Consent to Use Agreement stating:

“While the provisions in the consent agreements noted above may not be as stringent as the Examining Attorney would have preferred, the fact remains that the agreements between these two parties selling non-identical but related products on the question of likelihood of confusion are entitled to substantial weight. These

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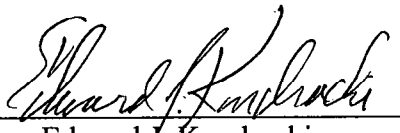
In view of all the foregoing, and especially the Agreement between the parties acknowledging the lack of actual confusion, the mutual belief that there is no likelihood of confusion and the steps to be taken, to avoid any future likelihood of confusion, Applicant respectfully requests that the application be returned to the Examiner for reconsideration and withdrawal of the refusal to register.

To allow time for consideration of this matter, and in the interest of judicial economy, it is also requested that the period for filing an Appeal Brief be extended three (3) months to November 15, 2005.

The application is in condition for allowance in all other respects. Therefore, passage of the application to publication for opposition is earnestly solicited.

Respectfully,

MILES & STOCKBRIDGE P.C.

By: 
Edward J. Kondracki
Reg. No. 20,604

1751 Pinnacle Drive, Suite 500
McLean, Virginia 22102-3833
Telephone: (703) 610-8627
#9278306v1

CONSENT TO USE AND REGISTER AGREEMENT

THIS AGREEMENT dated and effective the 10th day of June 2005, is entered into by and between Blundstone Australia Pty Ltd, an Australian Proprietary Company formerly Blundstone Pty Ltd., having its principal place of business at 88 Gormanston Road, Moonah, Tasmania 7009, Australia (hereinafter "BLUNDSTONE"), and Pyramex Safety Products, LLC, a limited liability corporation duly organized and existing under the laws of the state of Tennessee, having its principal place of business at 281-A Moore Lane, Collierville, Tennessee 38017 (hereinafter "PYRAMEX");

WHEREAS, BLUNDSTONE has applied for Federal Trademark Registration of the mark "MATADOR" in connection with protective clothing, namely high visibility clothing including high visibility vests, chemically resistant clothing including chemically resistant aprons and overalls, heavy duty protective clothing, namely heavy duty overalls and aprons, in International Class 9 and footwear, namely safety footwear, in International Class 25, respectively, the application having been assigned Serial No. 76/519,909;

WHEREAS, BLUNDSTONE represents that it has a bona fide intent to use the mark MATADOR in commerce on the goods set forth in Application Serial No. 76/519,909, namely protective clothing, namely high visibility clothing including high visibility vests, chemically resistant clothing including chemically resistant aprons and overalls, heavy duty protective clothing, namely heavy duty overalls and aprons, and footwear, namely safety footwear;

WHEREAS, PYRAMEX represents that it is the owner of Federal Registration No. 2,745,319 for the mark "MATADOR" for use on safety spectacles and industrial eyewear, namely, protective glasses and goggles, in International Class 9;



WHEREAS, BLUNDSTONE and PYRAMEX believe that there would be no likelihood of confusion as to the use of their respective marks in connection with their respective goods and the parties are desirous of avoiding confusion in the marketplace as to the source of the goods marketed or offered or intended to be marketed or offered under the mark **MATADOR** of the respective parties;

NOW, THEREFORE, in view of the above premises and recitals and of the mutual covenants expressed hereinafter, **IT IS HEREBY AGREED** by and between the parties as follows:

1. BLUNDSTONE and PYRAMEX agree that the above premises and recitals are to be considered part of this Agreement.
2. Subject to the restriction of Paragraphs 5 and 6, PYRAMEX agrees that BLUNDSTONE may use the name and mark **MATADOR** in commerce on protective clothing and safety footwear.
3. PYRAMEX, subject to the restrictions of Paragraphs 5 and 6 herein, hereby consents to the use and registration by BLUNDSTONE of the mark **MATADOR** in commerce on protective clothing and safety footwear.
4. PYRAMEX, subject to the restrictions of Paragraphs 5 and 6 herein, agrees that it will not oppose BLUNDSTONE's application for registration, Serial No. 76/519,909, for the **MATADOR** mark for use on said goods, and that it will not Petition to Cancel any registration resulting from Application Serial No. 76/519,909 for the mark **MATADOR** for said goods.
5. BLUNDSTONE agrees that it will not use the **MATADOR** mark on the safety spectacles and industrial eyewear, namely, protective glasses and goggles identified in Registration No. 2,745,319, nor on sunglasses. BLUNDSTONE further agrees that it will not Petition to Cancel

Registration No. 2,745,319 or file any opposition to an expansion of Pyramex's trademark to include sunglasses.

6. BLUNDSTONE and PYRAMEX agree that, in the event that either party becomes aware of and notifies the other of any instance of actual confusion in the marketplace resulting from the parties' use of their respective marks, the parties will, by actions not inconsistent with their interests in the rights to their marks, cooperate to attempt to correct such confusion and to avoid future confusion.

7. This Agreement contains the ENTIRE AGREEMENT between and among BLUNDSTONE and PYRAMEX, and each has carefully read the foregoing and knows and understands the contents and meaning thereof, and that the terms hereof are contractual and not a mere recital, and both BLUNDSTONE and PYRAMEX have signed this CONSENT TO USE AND REGISTER AGREEMENT with the intent to be legally bound hereby.

8. This Agreement is binding and inures to the benefit of any successors and assignees of the parties.

Blundstone Australia Pty Ltd

Attest: [Signature]

By: [Signature]

Date: 26. 7. 05

Name: Andrew Ross

Title: Company Secretary

Pyramex Safety Products, LLC

Attest: Sarah Madanil

By: [Signature]

Date: 7/6/2005

Name: S. MICHAEL SLATER

Title: PRESIDENT

My Commission Expires Feb. 6, 2006

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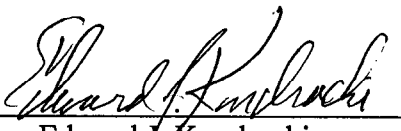
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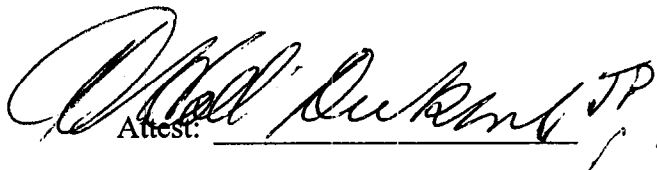
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Attest:  JP

Date: 26. 7. 05

Blundstone Australia Pty Ltd

By: 

Name: ANDREW ROSS

Title: COMPANY SECRETARY

Attest: Sarah Madanil

Date: 7/6/2005

Pyramex Safety Products, LLC

By: 

Name: S. MICHAEL SLATER

Title: PRESIDENT

My Commission Expires Feb. 6, 2006

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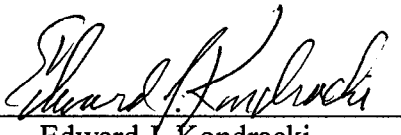
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#9278306v1

CONSENT TO USE AND REGISTER AGREEMENT

THIS AGREEMENT dated and effective the 10th day of June 2005, is entered into by and between Blundstone Australia Pty Ltd, an Australian Proprietary Company formerly Blundstone Pty Ltd., having its principal place of business at 88 Gormanston Road, Moonah, Tasmania 7009, Australia (hereinafter "BLUNDSTONE"), and Pyramex Safety Products, LLC, a limited liability corporation duly organized and existing under the laws of the state of Tennessee, having its principal place of business at 281-A Moore Lane, Collierville, Tennessee 38017 (hereinafter "PYRAMEX");

WHEREAS, BLUNDSTONE has applied for Federal Trademark Registration of the mark "MATADOR" in connection with protective clothing, namely high visibility clothing including high visibility vests, chemically resistant clothing including chemically resistant aprons and overalls, heavy duty protective clothing, namely heavy duty overalls and aprons, in International Class 9 and footwear, namely safety footwear, in International Class 25, respectively, the application having been assigned Serial No. 76/519,909;

WHEREAS, BLUNDSTONE represents that it has a bona fide intent to use the mark MATADOR in commerce on the goods set forth in Application Serial No. 76/519,909, namely protective clothing, namely high visibility clothing including high visibility vests, chemically resistant clothing including chemically resistant aprons and overalls, heavy duty protective clothing, namely heavy duty overalls and aprons, and footwear, namely safety footwear;

WHEREAS, PYRAMEX represents that it is the owner of Federal Registration No. 2,745,319 for the mark "MATADOR" for use on safety spectacles and industrial eyewear, namely, protective glasses and goggles, in International Class 9;



WHEREAS, BLUNDSTONE and PYRAMEX believe that there would be no likelihood of confusion as to the use of their respective marks in connection with their respective goods and the parties are desirous of avoiding confusion in the marketplace as to the source of the goods marketed or offered or intended to be marketed or offered under the mark **MATADOR** of the respective parties;

NOW, THEREFORE, in view of the above premises and recitals and of the mutual covenants expressed hereinafter, **IT IS HEREBY AGREED** by and between the parties as follows:

1. BLUNDSTONE and PYRAMEX agree that the above premises and recitals are to be considered part of this Agreement.

2. Subject to the restriction of Paragraphs 5 and 6, PYRAMEX agrees that BLUNDSTONE may use the name and mark **MATADOR** in commerce on protective clothing and safety footwear.

3. PYRAMEX, subject to the restrictions of Paragraphs 5 and 6 herein, hereby consents to the use and registration by BLUNDSTONE of the mark **MATADOR** in commerce on protective clothing and safety footwear.

4. PYRAMEX, subject to the restrictions of Paragraphs 5 and 6 herein, agrees that it will not oppose BLUNDSTONE's application for registration, Serial No. 76/519,909, for the **MATADOR** mark for use on said goods, and that it will not Petition to Cancel any registration resulting from Application Serial No. 76/519,909 for the mark **MATADOR** for said goods.

5. BLUNDSTONE agrees that it will not use the **MATADOR** mark on the safety spectacles and industrial eyewear, namely, protective glasses and goggles identified in Registration No. 2,745,319, nor on sunglasses. BLUNDSTONE further agrees that it will not Petition to Cancel

Registration No. 2,745,319 or file any opposition to an expansion of Pyramex's trademark to include sunglasses.

6. BLUNDSTONE and PYRAMEX agree that, in the event that either party becomes aware of and notifies the other of any instance of actual confusion in the marketplace resulting from the parties' use of their respective marks, the parties will, by actions not inconsistent with their interests in the rights to their marks, cooperate to attempt to correct such confusion and to avoid future confusion.

7. This Agreement contains the ENTIRE AGREEMENT between and among BLUNDSTONE and PYRAMEX, and each has carefully read the foregoing and knows and understands the contents and meaning thereof, and that the terms hereof are contractual and not a mere recital, and both BLUNDSTONE and PYRAMEX have signed this CONSENT TO USE AND REGISTER AGREEMENT with the intent to be legally bound hereby.

8. This Agreement is binding and inures to the benefit of any successors and assignees of the parties.

Attest: [Signature] JP

Date: 26. 7. 05

Blundstone Australia Pty Ltd

By: [Signature]

Name: ANDREW ROSS

Title: COMPANY SECRETARY

Attest: Sarah Madanil

Date: 7/6/2005

Pyramex Safety Products, LLC

By: [Signature]

Name: S. MICHAEL SLATER

Title: PRESIDENT

My Commission Expires Feb. 6, 2006